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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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MCDONNELL BOEHNEN HULBERT & BERGHOFF 300 SOUTH WACKER DRIVE SUITE 3200 CHICAGO, IL 60606				
			EXAMINER	
			SWICKHAMER, CHRISTOPHER M	
			ART UNIT	PAPER NUMBER
			2662	

DATE MAILED: 10/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/515,798

Applicant(s)

SCHUSTER ET AL.

Examiner

Christopher M Swickhamer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 18.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. This Office Action is in response to the Amendment filed 08/06/03. The Examiner approves the changes to the specification. Amended claim 1 has been entered. Claims 2-16 have been added. Currently no claims are in condition for allowance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- In lines 19-21 of the claim, the claim indicates that the telecommunications network access station is used to assign a user identifier and a teleport number to the data network teleport during registration. The specification does not support this statement. The specification states that a telephony server sets the user identifier and the teleport number on page 24, lines 7-12, and on page 28, lines 4-11.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites the limitation "the data network telephone service" in line 19. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3, 5-13 and 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Kung et al (USP 2003/0133558, hereafter Kung).

- Referring to claim 1 as best understood by the Examiner, Kung discloses a data network telephone system comprising: a data network to provide data connectivity for a plurality of data communications channels (Fig. 1, paragraph [0027]); a broadband residential gateway (BRG, telecommunications network access station) connected to a data network, the data network operable to communicate voice signals as voice over data packets on a voice-over data channel

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(paragraph [0041]), the voice over data channel being one of the plurality of data communications channels on the data network; the BRG (telecommunications network access station) having a station transceiver interface operable to communicate on at least one wireless connection (Fig. 3, '345', paragraph [0082]) and a BRG (teleport connection controller) operable to initiate a connection to a data communications channel (paragraph [0080]); at least one digital wireless handset (data network teleport) having a wireless transceiver interface, a voice processing system, an audio input, and an audio output, the voice processing system operable to receive voice signals from the audio input and to communicate the voice signals over the wireless transceiver to the BRG (telecommunications network access station), the voice processing system operable to receive voice signals from the network premises gateway (telecommunications network access station) and to couple the voice signals to the audio output and the IP telephone (data network teleport, paragraph [0027], [0081]) registered to the data network telephone service and assigned an IP address (user identifier) and port address (teleport number) by the domain name service server (telecommunications network access station), the port address (teleport number) identifying a teleport channel within the BRG (telecommunications network access station) which is coupled to a data communications channel by the teleport connection controller when a connection is initiated (paragraph [0046]) .

- Referring to claim 2, Kung discloses the system of Claim 1, wherein the teleport number is a User Datagram Protocol (UDP) port number (paragraph [0046]).

- Referring to claim 3, Kung discloses the system of Claim 1, wherein the station transceiver interface is a radio-frequency antenna (Fig. 3, paragraph [0081]).

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- Referring to claim 5, Kung discloses the system of Claim 1, wherein the telecommunications network access station includes a data network interface and a unique network address (paragraph [0046], [0080]).

- Referring to claim 6, Kung discloses the system of Claim 1, wherein the telecommunications network access station includes user account information and device identifiers for each data network teleport (paragraph [0039], [0046]). The BRG contains information to allow for connection setup between the various devices and interacts with the administration center for billing purposes.

- Referring to claim 7, Kung discloses the system of Claim 1, wherein the telecommunications network access station communicates over the data network by connecting to a first access network (Fig. 1).

- Referring to claim 8, Kung discloses the system of Claim 1, wherein the data network teleport contains a central processing unit and memory to store and process computer programs. IP telephones have central processing units and memories to store various programs (paragraph [0027]).

- Referring to claim 9, Kung discloses the system of Claim 1 further comprising a portable information device (PID) connected to a data network teleport, wherein the PID is operable to accept PID data from a user and transmit that data across the data network via the data network teleport (paragraph [0081]). Any number of devices that could be connected to an IP enabled phone could be used to transmit data across the data network. These devices could be palm devices, PDAs, etc.

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- Referring to claim 11, Kung discloses the system of Claim 1 further comprising at least one data network telephone that may communicate over the data network via an access network, the data network telephone including a voice input, a voice output, and a voice processing system (Fig. 1, paragraph [0081]).

- Referring to claim 12, Kung discloses the system of Claim 11, wherein the data network telephone includes a unique network address to identify it to the data network (paragraph [0046]).

- Referring to claim 13, Kung discloses a method for communicating on a data network telephony system, comprising in combination: accepting user input at a first portable information device linked to a data network teleport; transmitting the user input across a data network via a telecommunications network access station; and displaying the user input at a second portable information device (Fig. 1, paragraph [0080]-[0083]). Any number of devices can be used to transmit data across the data network to be displayed to the called user.

- Referring to claim 10, Kung discloses the system of Claim 9, wherein the PID contains a user profile that is uploaded to the data network teleport and transmitted to the telecommunications network access station during registration of the data network teleport (Fig. 1, [0039]).

- Referring to claim 16, Kung discloses the method of Claim 13, wherein each portable information device communicates with the data network via an access network (Fig. 1, paragraph [0080]).

- Referring to claim 17, Kung discloses the method of Claim 16, wherein the access network is a Local Area Network (LAN, paragraph [0081]).

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- Referring to claim 18, Kung discloses the method of Claim 16, wherein the access network is a cable network (paragraph [0080]).

- Referring to claim 19, Kung discloses the method of Claim 16, wherein the access network connects to the data network through a router (paragraph [0037]).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of Gernert et al (USP 6,600,734, hereafter Gernert)

- Referring to claim 4, Kung discloses the system of Claim 1, but does not expressly disclose wherein the station transceiver interface communicates using the 2.4 Ghz. Direct Sequence Spread Spectrum (DSSS) scheme. Gernert discloses a system that uses a 2.4 Ghz spread spectrum to communicate voice over IP packets. The system of Kung could be modified to use a 2.4 Ghz spread spectrum system to transmit the packets. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the system of Kung to use the 2.4 Ghz spread spectrum scheme to communicate the voice packets. One of ordinary skill in the art would have been motivated to do this since the 2.4 Ghz spectrum is set aside for home use, and using spread spectrum adds security to the signal to ensure privacy of the conversation.

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10. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung in view of MacMillan et al (USP 6,278,707, hereafter MacMillan).

- Referring to claims 14 and 15, Kung discloses the method of Claim 13, but does not expressly disclose wherein the user input is received at a data network telephone and transmitted to the first or second portable information device via a point-to-point link. MacMillan teaches using point-to-point links in a setting used to transmit voice over IP (col. 3, lns. 60-col. 4, lns. 5, col. 6, lns. 23-30). The system of Kung could be modified to use point-to-point links to transmit information from one user to another. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the system of Kung, with the use of point-to-point links. One of ordinary skill in the art would have been motivated to do this since using point-to-point links is a well known way of connecting users to Internet Service Providers. Using point-to-point links ensures that the device will be compatible with the technology used by service providers.

Response to Arguments

11. Applicant's arguments with respect to claim 1 have been considered but is moot in view of the new ground(s) of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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- A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ranalli et al, USP 2003/0076933 A1. *Method and Apparatus for Correlating a Unique Identifier, such as a PSTN Telephone Number, to an Internet Address to enable communications over the Internet.*
- Sayers et al, USP 2003/0186694 A1. *Method and Apparatus for Integrated Wireless Communications in Private and Public Network Environments.*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M Swickhamer whose telephone number is (703) 306.4820. The examiner can normally be reached on 8:00-4:30 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (703) 305-4744. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305.3900.

CMS

October 16, 2003



HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600